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HAROLD B. WILLEY, Cle

IN THE

Supreme Court of the United States

OCTOBER TERM, 1954

No. 580

WARNER BROS. PICTURES, INC. and ALFRED A. KNOPF, INC.,

Petitioners,

vs.

COLUMBIA BROADCASTING SYSTEM, INC.; WILLIAM SPIER; THE WILDROOT COMPANY, INC.; REGIS RADIO CORPORATION, WILLIAM ROBERT TALLMAN, GILES B. DOUD, JOE EISINGER, BATTEN, BARTON, DURSTINE & OSBORN, INC., and DASHIELL HAMMETT,

Respondents.

BRIEF OF RESPONDENT DASHIELL HAMMETT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT

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I. The Question Presented

Did the fictional mystery writer who granted the rights in various fields as to one story, in an agreement silent as to character or sequel rights, thereby debar himself under the circumstances of this case from the use made in later stories in the same fields of named characters originating in such story?

This is the sole decisive question in the case. Its determination in the negative below should not be reviewed by this Court.

II. Statement of the Case

The respondent Dashiell Hammett, is an author of detective and mystery stories who wrote the detective story involved herein, "The Maltese Falcon," some time in 1929. Later in the same year he had this story published serially in separate monthly magazine installments, each separately copyrighted by the magazine publisher. Prior to the writing of that story or on March 29, 1928, he had entered into a contract with the book publisher Knopf relating to another detective work of his, entitled "Red Harvest," pursuant to which Knopf would and did acquire the same rights in the later work "The Maltese Falcon," as it had acquired for "Red Harvest," those rights being expressly limited to those "rights comprised in the copyright to the said work" which were therein "specifically granted" to Knopf (Ex. 33, Third (C); R. 124, 491).

Following this first serial publication and prior to the Warner agreement of June 23, 1930 (Ex. 3; R. 37, 452), Knopf received from the magazine publisher an assignment of the magazine copyrights on "The Maltese Falcon" and published and copyrighted the work in book form. The work was a success (R. 184-186, 474-481). It was the first of the author's four published stories in which his fictional detective character, Sam Spade, appeared. None of the three later stories published after this Warner agreement were ever sold to or used by Warner. His later three Sam Spade stories, one containing "Spade" in its title, first appeared in magazines commencing in 1932. Besides the leading detective character named Sam Spade, there also appeared by name in these stories some of the other characters found in "The Maltese Falcon." Commencing in 1944 these three stories were published in

a collection entitled "The Adventures of Sam Spade and Other Stories by Dashiell Hammett" which was published in several editions, with numerous reprintings (Ex. D; R. 453, 524, 107, 208-212, 458, 520).

In utilizing his characters, particularly Sam Spade as the central detective figure in successive different detective stories the author was following a well-known custom of long standing in the detective story writing field. Long prior to the advent of motion pictures and for well onto a century numerous leading detective story writers followed that practice as did Sir Arthur Conan Doyle in relation to his fictitious detective "Sherlock Holmes" (R. 216, 219, 222-225).

The pivotal contract in this case, the 1930 agreement between Warner the motion picture company as "Purchaser" on the one hand and Knopf the book publisher and Hammett the author on the other as "Owners" (R. 37) was drawn by Warner, a wide and experienced user and dealer in literary properties and provided for its interpretation according to "Federal" and New York law (R. 49). That agreement is conspicuously silent about and shows no sale, grant or disposal concerning name, sequel, character or continuation rights in relation to Sam Spade or other characters. In fact, that name is nowhere mentioned in the agreement; nor is there any covenant or restriction relating to the author's writing of any other stories using any of the characters in "The Maltese Falcon." On its face, that agreement at most purports to transfer for a consideration of $8,500.00 motion picture, radio and television rights in "The Maltese Falcon."

After the execution of this 1930 agreement Warner produced and distributed three motion pictures based upon "The Maltese Falcon", none of them bearing a title containing the name "Sam Spade." The first and third of these, produced in 1931 and 1941 respectively, were entitled "The Maltese Falcon", but the second, produced

in 1936, bore the title of "Satan Met A Lady", and contained no character named Sam Spade therein (R. 107).

On May 15, 1946, the author granted an authorization to certain of the respondents herein for the use in radio and other media of the character Sam Spade and the title "The Adventures of Sam Spade" (Ex. 7, R. 51, 453). Thereafter, commencing in July, 1946, and almost continually to 1950, weekly transcontinental broadcasts entitled "The Adventures of Sam Spade" ensued. These radio programs were written, produced, broadcast and sponsored by the other respondents (R. 103, 109, 454-456). This grant was later orally enlarged to include other characters in "The Maltese Falcon" (R. 109). The radio series reached vast, nation-wide radio audiences, was extensively and regularly advertised and promoted, was highly popular and received a number of radio mystery program awards (Ex. SS; R. 512-515). This series merely used the characters by name. There was no "textual copying" of "The Maltese Falcon" (Petition, Appendix B, p. 27).

Notice of claim by Warner was not given herein until early in 1948 and this suit was not brought until May 28, 1948, or until almost two years after the commencement of these transcontinental broadcasts (R. 457).

Although Knopf was aware of the later Sam Spade stories it has never protested concerning them (R. 501); nor has Warner (R. 103). Nor has Knopf ever protested concerning the radio series. Knopf is a formal party only in this action, makes no claim and has no beneficial interest in Warner's claim (R. 7).

The decision of the District Court dismissing the complaint was unanimously affirmed by the Court of Appeals.

III. Reasons for Denying the Writ

1. The narrow, private and particular contract controversy here presented has been resolved below with unanimous affirmance on grounds just and reasonable.

The rights claimed here by the petitioner Warner derive only from its 1930 agreement, the ultimate source of any such grant. This poses a question of contract construction to ascertain the intent of the parties as to the scope of the transfer. The determination of such a contractual question between private parties on special facts as to rights acquired under a particular contract, presents no issue of public interest or importance for the purpose of review by this Court. This is especially so when the District Court decision dismissing the complaint has received, following a well reasoned opinion, the unanimous affirmance of the Court of Appeals. *Graver Mfg. Co.* v. *Linde Co.*, 336 U. S. 271, 275 (1949).

Moreover, a consideration of the facts and a reading of both opinions below demonstrate that the decision is not only reasonable, but undoubtedly just and correct in resolving the contractual question which is decisive in this case. In arriving at the conclusion that Warner did not acquire the rights claimed, the Court of Appeals pointed to the omission of such language in the contract as would be necessary to sustain Warner's contention; the fact that the contract was prepared by Warner, a large and experienced user and dealer in literary property; the existence of a custom or practice of long duration for detective fiction writers to carry their central or important characters from one story into succeeding stories; the apparent inadequacy of the purchase price if the claimed rights had been included; the conduct of the parties subsequent to the agreement, including the failure of the petitioners to offer any objection to the use by the author of his characaters

in stories later published and to assert the claims herein reasonably soon after the commencement of respondents' broadcasts.

Indeed, the Court of Appeals concluded that the sharply contrasting omission in the Warner prepared instrument of any language with respect to the rights claimed as against the itemization of the rights which were expressly granted, sufficed to show that the rights claimed were not acquired. According to the Court's opinion there was evidently no ambiguity to be resolved. The other facts merely "buttressed" that Court's conclusion. The District Court similarly stressed most of these facts but for the purpose of resolving what it regarded as an omission or ambiguity arising from the contractual silence on the rights in issue.

2. The holding below does not result in any conflict of decisions.

As is self-evident in the opinion below, the holding of the Court of Appeals is solely on the facts of contractual intention.

> "Up to this point we have discussed the points at issue by construing the contract and by seeking the intention of the parties to it, and we have concluded that the parties never intended by their contract to buy and sell the future use of the personalities in the writing." (Petition, Appendix B, p. 25)

The Court then went on to say by way of *obiter dictum* that even if the instant case had involved only an assignment of "complete rights in the copyright" (and without the other facts and the limiting language of the contract in this case) such complete copyright assignment would not prevent the author from using the characters of "The Maltese Falcon" in other stories because these "characters with their names" are not protected by copyright *per se*. (Petition, Appendix B, pp. 26-27). Obviously, the Court's

holding rests on a contractual ground, because the decision would necessarily be the same as a matter of contractual intent under the circumstances of this case even if the court's dictum had been contrariwise.

Not only is the contractual decision itself not at variance with any other decisions, but the dictum itself is consistent with theory expressed and applied in the cases which petitioners cite as the conflicting decisions in the Second Circuit (Petition, point 3, pp. 11, 12).

Under those cases the courts in dealing with the ordinary copyright plagiarism problem—not our situation here—of whether a defendant has appropriated actually or colorably a substantial portion of the plaintiff's literary or cartoon text, conceive the copyright question as one limited to textual appropriation, *i.e.*, whether the expression of pictorial or literary details, including specific incidents or exploits, has been copied. This doctrine is enunciated in the two principal "conflict" cases cited by petitioners. *Nichols* v. *Universal Pictures Corp.*, 45 F. 2d 119, 121 (CCA 2, 1930); *Detective Comics, Inc.* v. *Bruns Publications, Inc.*, 111 F. 2d 432, 433 (CCA 2, 1940). The Second Circuit has recently confirmed this concept, citing these cases. *National Comics Publications, Inc.* v. *Fawcett Publications, Inc.*, 191 F. 2d 594, 600, 603 (1951); *opinion clarified*, 198 F. 2d 927 (1952).

This view has recently been followed by the Supreme Court of California in *Burtis* v. *Universal Pictures Co. Inc.*, 40 Cal. 2d 823, 835, 256 P. 2d 933 (1953), wherein the Court cited the *Detective Comics* case, *supra*, and the decision by the District Court in the instant case. The District Court here cited the *Detective Comics* and *Nichols* cases (R. 86, 87, 90), the latter also discussed by the Court below.

The above cases, all consonant with the opinion below, do not, however, touch the theory of protection for the use of named characters short of the textual invasion of a copyrighted work. Petitioners' argument that such use

too is protectable under copyright and for the benefit of the copyright owner, or not at all, is refuted by *Fisher* v. *Star Co.*, 231 N. Y. 414, 132 N. E. 133 (1921), *cert. den.*, 257 U. S. 654. In that case, the author and creator of a series of published but uncopyrighted[1] cartoon strips depicting the named characters "Mutt" and "Jeff" enjoined on the ground of unfair competition, a publisher, who had thereafter published and copyrighted other "Mutt" and "Jeff" cartoons by the author, pursuant to an exclusive term contract with him, from publishing after the termination of that agreement "Mutt" and "Jeff" cartoons drawn by another. *Kurlan* v. *Columbia Broadcasting System, Inc.*, 40 Cal. 2d 799, 256 P. 2d 962 (1953) cited by petitioners for the proposition that "after publication * * * characters are not protected by the common law" (Petition, p. 10), is not in point. That case decided by the Supreme Court of California on the same day, April 29, 1953, as the *Burtis* case, *supra*, did not involve the defendant's use of the same named characters of the author. So far as pertinent here, it was decided by virtue of certain local statutory provisions, applicable to the plagiarism claim there presented (Cal. Code, Secs. 980, 983).

The right to the use of the publicized named characters created by an author and identified with him is protected, unless abandoned, under the common law doctrine of unfair competition and vests in the author and his assigns. See *Fisher* v. *Star Co.*, *supra* (pp. 431-433).

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[1] Of the hundreds of "Mutt" and "Jeff" strips by the plaintiff which had preceded the defendant's copyrighted ones, all excepting three copyrighted by the plaintiff had been published without copyright. These three involving only "Mutt" appeared subsequent to the publication without copyright of an initial group of about twenty-five "Mutt" cartoons. The defendant's copyrighted strips numbered approximately two thousand. These facts, conceded in the briefs on appeal (Appellant's Brief, p. 2; Respondent's Brief, pp. 13, 14, 45-47), become apparent from the findings of fact and conclusions of law set out in full preceding the opinion (pp. 415-426, 415, 416). The Court admonishes a reading of these for an understanding of "the true basis of the decision" (p. 428).

In *Atlas Mfg. Co.* v. *Street & Smith*, 204 Fed. 398 (C. C. A. 8, 1913), *app. dism.*, 231 U. S. 348, *cert. den.*, 231 U. S. 755, the suit was by the publisher of a weekly publication entitled "Nick Carter" which contained uncopyrighted stories of a fictional detective by that name. The defendant was a motion picture producer who was about to release a film using that name within its title and for the detective character in the film itself. In denying plaintiff an injunction the court found no competition between the plaintiff's publication and the defendant's motion picture. There was no showing or claim of an assignment of character rights from the author. The latter was not a party to the action.

IV. CONCLUSION

The petitioner seeks the review of an interpretation of a contract between private parties under particular facts unanimously made by all judges in the Courts below. The decision is reasonable and manifestly correct. The so-called copyright ground urged as the basis for review is non-existent since it is at best dictum and moreover does not pose the asserted conflict with the holdings or even theory of cases in the Second Circuit.

The Court should therefore deny the petition for a writ of certiorari.

Respectfully submitted,

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